

Application No. 10/768,414

Amendment dated 07/27/2005 responding to Office Action dated 04/27/2005

### **REMARKS**

These remarks address the Examiner's comments made in the Office Action mailed 04/27/2005.

#### **Final Rejection**

Applicant respectfully submits that the office action should have been made non-final, rather than final, because none of Applicant's previous amendments necessitated the new office action. Fundamentally, there are no real "new grounds of rejection" in this second office action; there is simply a new reference which is just as relevant to the original claims as it is to the claims as amended in the response to the first office action.

Nothing added, deleted, or changed by Applicant in his response to the first office action made Anderson suddenly relevant.

Making this office action final is improper, as well as expensive for Applicant.

#### **(2) Rejection over Anderson**

Claims 1-4, 7, and 9-10 were rejected under 35 USC 102(b) as anticipated by Anderson.

Claim 1 has been amended to expressly recite that the inside measurement indicators are on the top side of the tape. Anderson teaches putting the inside measurement indicators and marks on the bottom side of the tape (figure 1; col. 1 lines 36-45; col. 2 lines 3-17; col. 3 lines 34-38, 63 to col. 4 line 2; col. 5 lines 52-56). Anderson's entire invention and entire disclosure, in fact, are entirely dependent upon using the bottom side of the tape for making inside measurements. By way of contrast, Applicant's invention is strictly limited to using the top side of the tape for both outside and inside measurements.

Regarding claim 3, the office action is somewhat incorrect, in that it ignores the fact that Anderson has separate distance marks on the two sides of the tape, and the ones on the bottom are placed to compensate for the curved final coil of the tape. That is, his inside measurement distance marks do not "indicat[e] a distance from the distal end of the tape to a corresponding distance mark plus the longitudinal exterior dimension of the housing" (emphasis added); they

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indicated a distance from the distal end of the tape to a corresponding distance mark plus the length of the curved segment of tape between the exit and the window.

Finally, it is significant that Anderson's device is inherently inaccurate. The bulk of his disclosure is devoted to techniques for dealing with the inherently variable length of tape in the segment of the outermost coil between the exit and the reading window. The key to Applicant's invention is that this problem is avoided by having both the inside and outside markings on the top side of the tape.

#### **(4) Rejection over Anderson and Usami**

Usami is well cited for teaching a "slop-mounted" end piece.

However, nobody would combine Anderson and Usami. Because Anderson's inside measurement markings are on the bottom side of the tape, one would simply adjust their position to compensate for the thickness of a rigidly (and more simply) mounted end piece. As Anderson says, "the position of scale 36 [on the bottom side of the tape] with respect to the hook 37 [the end piece] on the end of the tape determines the reading at lens 58 [as opposed to reading at the distal end exit]." (col. 4 lines 37-39; bracketed comments added)

The only real reason for having the slop (which, ideally, is exactly the thickness of the end piece) is to allow the same distance marks (the hash marks, not the numbers) to be used for both inside and outside measurements using the same side of the tape. Once one set of markings are moved to the other side of the tape, the slop mounting is wholly unnecessary and only adds expense and not accuracy.

#### **(5) Rejection over Anderson and Kuze**

Kuze is well cited for showing a housing that is 3.625 inches long.

However, Anderson expressly teaches away from such a combination as with Kuze. Anderson states that one of the objects of his invention is "to provide a tape measuring device capable of indicating inside measurements directly and independently of the case dimensions, since the direct reading inside measurement scale is compensated for the width of the housing of

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the tape.” (col. 2 lines 32-36) “If the housing had a greater or lesser width, then this width would be the minimum reading of scale 36.” (col. 3 lines 70-72) “The housing itself is not necessarily limited to a width of two inches or any other particular width. This permits greater latitude in manufacturing, since the housing can be made larger or smaller for holding longer or shorter tapes. In any case, the positioning of scale 36 with respect to the hook 37 on the end of the tape determines the reading at lens 58.” (col. 4 lines 33-39) In fact, in one of his embodiments, the distance between the inside measurement marks is actually variable along the length of the tape, to compensate for the changing circumference of the coiled tape as the tape is withdrawn. (col. 5 lines 54-56)

**(6) Rejection over Anderson and Drechsler**

Drechsler teaches essentially the same thing as Anderson – a “top reading” tape measure which has its inside measurement markings on the bottom of the tape. (Note that “top reading” refers to reading the bottom side of the tape at the top of the housing.)

Their combination does not make obvious the claimed invention, which is limited to having the inside (and outside) measurement markings on the top side of the tape.

**(7) Rejection over Anderson and Chilton**

The “marking indicia (132)” referenced in the office action are orthogonal to the present invention and to Applicant’s claims.

The phrase “distance marks” in the claims refers to the “hash marks” – the set of regularly-spaced transverse lines. The phrase “distance indicators” in the claims refers to the numerical markings which indicate how far the various, corresponding distance marks are from the distal end of the tape. The distance indicators are arranged with and correlated with specific distance marks. Both the distance marks and the distance indicators are of the same “scale”; that is, if the tape measure is in English units, there will be a distance indicator every inch and a pattern of distance marks that repeats every inch.

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By way of contrast, Chilton's two sets of diamond-shaped "stations" (his rather odd term) 32, 34 in figure 1 (or 132, 134 in figure 3) are specifically not of the same scale as his quite conventional distance marks and distance indicators. Specifically, he teaches an English (one inch) scale for the distance marks and distance indicators, but a 14.5 inch scale for the one set of diamond-shaped stations and a 22.5 inch scale for the other. (col. 3 lines 2-4) Indeed, he specifically teaches that the scale of the stations "could be slightly different from these values and the present invention would still function (for example  $14 \frac{5}{32}$  inches)." (col. 4 lines 10-11)

Chilton's "stations" are not used for measurement at the scale of the inch marks. They are only used for cutting crude framing pieces which do not need to be cut to any particularly exact tolerance.

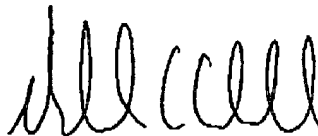
Combining Chilton with Anderson would, at best, give a top-reading tape measure with an outside measurement system on the top side of the tape, an inside measurement system on the bottom side of the tape, and some semi-variably placed diamond marks placed on some side of the tape at a completely different scale unrelated to that of the tape measure itself.

That has got nothing to do with the subject matter of Claim 12.

### CONCLUSION

Applicant respectfully requests allowance of all claims, as they are neither anticipated nor made obvious by the references cited. Applicant also requests withdrawal of the finality of the office action, which was not warranted at this time.

Respectfully submitted,



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